

REMARKS

No claims have been amended, no claims have been canceled, and no new claims have been added. Claims 1-6, 11-17, 22-28 and 33 are pending.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Claim Rejections – Double Patenting

The Office Action rejected claims 1-6, 11-17, 22-28 and 33 as conflicting with claims 1-33 of Application No. 10/840,889 (“the child application”). The Examiner is requested to hold these rejections in abeyance pending an allowance of claims in this or the child application.

Claim Rejections - 35 USC § 102

The Office Action rejected claims 1, 2, 4, 5, 11-13, 15, 16, 22-24, 26, 27 and 33 under 35 USC § 102(e) as anticipated by Slotznick (US 7,058,356). This rejection is respectfully traversed.

Claims 1, 12 and 23 are independent. The independent claims generally recite three devices, namely a client computer, a first telephone and at least one second telephone. As recited in the claims, the client computer scans a data unit for telephone numbers and automatically identifies a telephone number within the data unit. Further, the client computer packages a phone number object corresponding to the identified telephone number. Importantly, the object is (a) activatable and (b)

defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between [i] a first telephone corresponding to a telephone number associated with a user of the client computer and [ii] a second telephone corresponding to the identified telephone number.

In contrast, Slotznick is directed to television system having a SetTop Box and a telephone 321 that doubles as a remote control for the SetTop Box 317, where the telephone may also be a cellular telephone. Slotznick teaches that the SetTop Box transmits a telephone number to the telephone, and the user initiates a telephone call by clicking a button on the phone. (Slotznick, 12:58- 13:13) There is no teaching in Slotznick of a client computer that packages an object that defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between two telephones specified by two telephone numbers included in the object.

More specifically, pertinent limitations of the independent claims include:

Claims 1 and 12:

scanning the data unit for telephone numbers

automatically identifying at least one telephone number within the data unit

packaging an object corresponding to the identified telephone number, wherein

the object is defined such that the telephone number is activatable

the object defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between a first telephone corresponding to a telephone number associated with the user of the client computer and a second telephone corresponding to the identified telephone number, wherein the first telephone

and the second telephone are separate and distinct from each other and are separate and distinct from the client computer

Claim 23:

scan a data unit for telephone numbers

automatically identify at least one telephone number within the data unit

package a phone number object corresponding to the identified telephone number, wherein the object is defined such that the telephone number is activatable and the object defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between a first telephone corresponding to a telephone number associated with a user of the client computer and a second telephone corresponding to the identified telephone number, wherein the first telephone and the second telephone are separate and distinct from each other and are separate and distinct from the client computer

Thus, the independent claims recite initiation of telephone calls in the following way, **(1) the client computer scans** the data unit for telephone numbers, **(2) the client computer automatically identifies** at least one telephone number within the data unit, and **(3) the client computer packages a phone number object** corresponding to the identified telephone number, wherein the object is (a) **activatable** and (b) **defines a function for sending a data trigger to a switch** over a data network to initiate a telephone call over a telephone network between [i] a first telephone corresponding to a telephone number associated with a user of the client computer and [ii] a second telephone corresponding to the identified telephone number. Importantly, the first telephone and the second telephone are separate and distinct from each other and are separate and distinct from the client computer.

In contrast, Slotznick is directed to television system having a SetTop Box and a telephone that doubles as a remote control for SetTop Box, where the telephone may also be a cellular telephone. Slotznick teaches that the SetTop Box transmits a telephone number to the telephone, and the user initiates a telephone call by clicking a button on the phone. (Slotznick, 12:58- 13:13) In this way, the user in Slotznick uses the telephone to place a telephone call. More specifically, Slotznick states:

When the telephone number (actually, data which contains the telephone number) is sent to the SetTop Box 317, it is transferred to a wireless transmitter 319 in the SetTop Box 317. ... The wireless transmitter transmits the data containing telephone number. The data is received by the wireless receiver 323 in any nearby TV Phone 321. When such a signal is received, the TV phone 321 loads the number into an auto-dialer 327 and activates a display light 325. ... When the user presses a specific button 329 on the TV phone keypad 333, the autodialer 327 will be activated. This causes the wireless phone 331 portion of the TV phone 321 to access the wireless phone service 337 (e.g., a cell phone network) by dialing the number that had been received from the TV Station 301 over the blanking interval signal and passed from the Television Receiver 303 through the SetTop Box 317 to the TV phone 321. (Slotznick, 12:58- 13:13)

The Office Action asserts that the SetTop Box 317 of Slotznick teaches the client computer recited in the independent claims. However, the functionality of the claimed client computer and the SetTop Box of Slotznick are wholly different. The claimed client computer packages an object that is "activatable" and "defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between a first telephone corresponding to a telephone number associated with a user of the client computer and a second telephone corresponding to the identified telephone number". In contrast, the SetTop Box of Slotznick merely transmits a phone number received as part of a television signal to a telephone that also serves as a remote control. The SetTop Box of Slotznick does not create an object as claimed. The SetTop Box

of Slotznick merely passes a phone number to the telephone, and a user uses the telephone to place a call to the phone number received from the SetTop Box. The SetTop Box of Slotznick does not create an object that defines a function for sending a data trigger to a switch over a data network. Moreover, there is no teaching in Slotznick of the object having the features recited in the independent claims. As such, the functionality of the claimed client computer and the SetTop Box of Slotznick are wholly different. Thus, Slotznick fails to teach the limitations recited in the independent claims. Therefore, the independent claims are patentable over Slotznick.

The Office Action also cites an alternate embodiment of Slotznick in which the phone number is not transmitted from the television receiver or SetTop box to the telephone. In this alternate embodiment, “phone numbers are transferred from the telemarketing service 405 to a data transmission service 407 which transmits the data to a wireless data receiver 409 in the TV phone 321”. (Slotznick, 15:37 – 16:28) As such, the SetTop box in this embodiment does not teach the limitations of the claimed client computer. More specifically, the SetTop Box of Slotznick does not create an object as claimed. The SetTop Box of Slotznick does not create an object that defines a function for sending a data trigger to a switch over a data network. Moreover, there is no teaching in Slotznick of the object having the features recited in the independent claims. As such, the functionality of the claimed client computer and the SetTop Box of Slotznick are wholly different. Thus, Slotznick fails to teach the limitations recited in the independent claims. Therefore, the independent claims are patentable over Slotznick.

The dependent claims are patentable by virtue of their dependency on the independent claims which have been shown to be patentable above.

Therefore, all claims are patentable over Slotznick, and this rejection should be withdrawn.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 3, 6, 14, 17, 25 and 28 under 35 USC § 103(a) as being unpatentable over Slotznick and Giordano (US 6,870,828). This rejection is respectfully traversed.

Claims 3, 6, 14, 17, 25 and 28 are dependent on claims 1, 12, and 23 respectively. As such, these claims inherit the limitations of claims 1, 12, and 23 discussed above which are not disclosed, taught or suggested by Slotznick. Giordano does not cure the deficiencies of Slotznick. Thus, the combination of Slotznick and Giordano fails to teach or suggest all of the limitations claimed. Therefore, by virtue of their dependency on claims 1, 12 and 23, claims 3, 14 and 25 are patentable over Slotznick and Giordano.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy, the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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